

REMARKS/ARGUMENTS

Claim 6 was withdrawn from consideration and is being cancelled.

The Abstract is being amended as required by the Examiner.

The Examiner has rejected claims 1-5 and 7-18 as being obvious over the combination of Stachowski (U.S. Patent 6,227,207), which discloses a hair styling device comprising a spring strip, in view of Cronk (U.S. Patent 6,244,265), a patent for a nasal strip which contains medication and fragrance. Reconsideration is requested.

A claim may be rejected for obviousness if “the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Examiner suggested that in view of Stachowski and Cronk, it would have been obvious to combine the two patents’ features and obtain a body covered with a scented sheet material, as claimed in claims 7 and 12. The applicant cannot agree.

Claims 7 and 12, the independent claims, are reproduced below:

7. A scented product comprising at least one body, a sheet material on the at least one body, and a fragrance-containing microcapsule material adhered to the sheet material.

12. A process for manufacturing a scented product comprising the steps of:

providing a product comprising a body, with a sheet material covering said body, and
applying a fluid to said sheet material, said fluid containing microcapsules which contain a fragrance.

The Examiner alleges that Stachowski discloses a sheet material on a body. On the contrary, Stachowski discloses coatings, not sheet materials. See col. 6, lines 26-42, which describes the use of soft plastics or resins as the coatings (lines 26-35), and emphasizes coatings that are bonded to the body (lines 35-42). In contrast, see the present application at page 3, lines 1-15, which defines “sheet material” as used herein. Stachowski’s coatings are not “sheet materials” as claimed in claims 7 and 12.

New dependent claims 19-22 further specify that the sheet material comprises a woven or non-woven fabric.

For all these reasons, Stachowski fails to disclose or suggest a “sheet material” disposed on a body according to claims 1-5 and 7-22.

The applicant also cannot agree that Stachowski and Cronk are combinable. Even if the hair clip in Stachowski comprised a sheet material, there would still be no conceivable motivation or suggestion in either Stachowski or Cronk of incorporating a fragrance into that hair clip.

Examiner acknowledged that “Stachowski fails to disclose or suggest ...fragrance-containing microcapsule material adhered to the sheet material.” To remedy this defect in Stachowski, the Examiner cited Cronk, as follows:

“Cronk discloses fragrance-containing microcapsule material 260 (Fig.7) (col.9, ln.5-16; col.12, ln.44-62) adhered to sheet material 230 (col.8, ln.41-45; col.9 ln.5-15) for easing the breathing of patients (col.1, ln.12-17; col.2, ln.40-45) and to incorporate fragrances and transdermal medications. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the sheet material disclosed by Stachowski to have a fragrance-containing microcapsule material adhered to the sheet material, as taught by Cronk, to incorporate fragrances and transdermal medications into the sheet.”

Cronk’s disclosure is a medical device. Its fragrance is provided so as to improve the breathing of patients with nasal congestion. The references fail to provide any motivation for applying a fragrance-containing microcapsule material to a hair clip, since a hair clip is disposed nowhere near the nose.

Further, Stachowski discloses a cosmetic device for holding the hair. One skilled in the art of making hair accessories would have no motivation to look to a medical nasal strip for ideas on how to create a new hair product.

In summary, there is no motivation disclosed in either Stachowski or Cronk for modifying Stachowski’s hair clip by applying Cronk’s fragrance material. The combination of references is motivated only by hindsight, using claims 7 and 12 as a guide to combining two references that would not have been combined by those skilled on the pertinent art. The rejections based on the combination of Stachowski and Cronk therefore should be withdrawn.

Dependent claims 1 and 13 recite that the scented product is a bracelet. On page 4 of the Office Action, the Examiner alleged that Stachowski discloses “a bracelet comprising a bracelet body 33 (Fig. 12).” Stachowski’s product in Fig. 12 is a hair clip, not a bracelet, as stated plainly at col. 7, lines 5-13. The Examiner’s comments about a bracelet are not based on the reference, but rather are based on a modification of the reference in which the Examiner, motivated solely by hindsight, appears to imagine that the Fig. 12 product is inherently a bracelet, despite the clear description of a hair clip in the reference. In fact, nothing in the reference even hints that the Fig. 12 product has a size appropriate to a bracelet, or a bracelet-like appearance, or mechanical qualities desirable in a bracelet. Nothing indicates that the hair clip of Fig. 12, was ever worn on a person’s wrist as of the issue date of the Stachowski reference. The Examiner’s comments are baseless and accordingly, the rejection of claims 1 and 13 and their dependent claims must be withdrawn.

Claims 3 and 15 depend respectively from claims 1 and 13 and recite that “said bracelet body comprises an elastic material which permits the bracelet to be slapped onto one arm by a one-handed movement of the other arm.” The Examiner chose to ignore this physical feature of the invention, stating that “the limitation ‘which ... arm’ holds no patentable weight because it is functional language. Refer to MPEP 2114.”

In fact, the Examiner has cited the wrong section of the MPEP. MPEP 2114 concerns claims that recite function divorced from structure. In such case, the functional language cannot distinguish the claim from the prior art. In this case, however, the phrase “which... arm” does describe and further limit structure of the “elastic material” recited earlier in claims 3 and 15.

There is no justification in MPEP 2114 or elsewhere for the Examiner editing the claims and removing part of the description of the claimed invention. The applicant, not the Examiner, defines the invention. Orthokinetics Inc. v. Safety Travel Chairs Inc., 1 U.S.P.Q. 2d 1081, 1082, 1087-88 (Fed. Cir. 1986); In re Borkowski, 164 U.S.P.Q. 642, 645-46 (CCPA 1970). If a claim is somehow improper it may be rejected under 35 U.S.C. 112. But it cannot be edited by the Examiner to make it rejectable over the prior art.

The Examiner’s contention that some of the language in claims 3 and 13 is considered “functional” and can be ignored is contrary to MPEP §2173.05(g), which provides:

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used... In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as “members adapted to be positioned” and “portions...being resiliently dilatable whereby said housing may be slidably positioned” serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). (Emphasis Added)

In In re Swinehart, 169 U.S.P.Q. 226 (C.C.P.A. 1971), the C.C.P.A. said there is no per se objection to “functional” language in claims, as long as it complies with §112; that is, it (1) does not fail to clearly indicate what subject matter is included in the claim; (2) does not impermissibly exceed the breadth of the enabling disclosure in the specification; and (3) does not recite a function that itself is old. If the “functional” language avoids those three difficulties, the claim is not improper.

The Court said:

We take the characterization ‘functional’ . . . to indicate nothing more than the fact that an attempt is being made to define something (in this case, a composition) by what it does rather than by what it is. In our view, there is nothing intrinsically wrong with the use of such a technique in drafting patent claims

We are convinced that there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that ‘functional’ language, in and of itself, renders a claim improper. We have also found no prior decision of this or any other court which [states any] ground for objecting to a claim on the basis of any language, ‘functional’ or otherwise, beyond what is already sanctioned by the provisions of 35 U.S.C. 112.

169 U.S.P.Q. at 228-229.

In Plastic Container Corp. v. Continental Plastics of Oklahoma, Inc., 203 U.S.P.Q. 650, 651 n.2 (10th Cir. 1979), citing Swinehart, the court said --

[W]e are unable to see merit in any proposition which would require the denial of a claim solely because of the type of language used to define the subject matter for which patent protection is sought.

In Rohm & Haas Co. v. Dawson Chem. Co., Inc., 217 U.S.P.Q. 515, 563 (S.D. Tex. 1983), rev'd on other grounds 220 U.S.P.Q. 289 (Fed. Cir. 1983), the court rejected the proposition that "functional" language made a claim per se indefinite under Section 112. The Court pointed out that:

In determining whether there has been compliance with §112, due consideration must be given to whether the subject matter in a particular case is of a nature that lends itself to precise definition, and allowance must be made for inherent imprecision in language as a means of such definition.

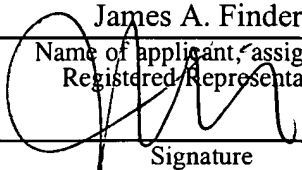
The court concluded:

The use of functional language to claim an invention is specifically approved by statute, the Patent Office and the courts, particularly where, as here, it is obviously impossible to enumerate all possible [ways the claimed function can be obtained].

In summary, the grounds for rejection of claim 1, 3, 7, 12, 13 and 15 and their dependent claims are incorrect and should be withdrawn. For at least these reasons, allowance of claims 1-22 is requested.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 22, 2003:

James A. Finder

Name of applicant, assignee or
Registered Representative


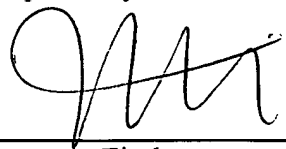
Signature

August 22, 2003

Date of Signature

JAF:msd:mjb
Enclosure

Respectfully submitted,



James A. Finder
Registration No.: 30,173
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700